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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,743	03/31/2004	Jeffrey D. Ollis	BCS03153	7191

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MAYER & WILLIAMS PC  
251 NORTH AVENUE WEST  
2ND FLOOR  
WESTFIELD, NJ 07090

EXAMINER
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SANDOVAL, KRISTIN D

ART UNIT	PAPER NUMBER
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2132

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/814,743

Applicant(s)

OLLIS ET AL.

Examiner

Kristin D. Sandoval

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-21 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1:

It is unclear how a predetermined service can be disabled from within the network device upon the predetermined service being accessed by the network device since disabling the service would discontinue access to the service, therefore leading to the network device unsuccessfully accessing the predetermined service, thus leading to the network device activating the predetermined service within the device. Thus, the examiner interprets activating the service as activating the service within the device and disabling as not activating the service from within the device.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2132

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 15, 16, 18 and 19 rejected under 35 U.S.C. 102(e) as being anticipated by  
Nurmann, U.S. Patent No. 6,560,642.

As per claims 1-4, 8 and 10-14:

Nurmann discloses a method (20) for automatically self-configuring a network device  
being added to a network comprising:

attempting (21) to access a NAT, DHCP or DNS service from the network, which NAT,  
DHCP or DNS service is also capable of being performed by the network device (4:36-50, claim  
2);

upon (24) successfully accessing the DHCP service by the network device, disabling the  
NAT, DHCP or DNS service within the network device (2:43-67, claim 2); and

upon (23) unsuccessfully accessing the DHCP service by the network device, activating  
the NAT, DHCP or DNS service within the network device (2:43-67, claim 2);

acquiring (31) an Internet Protocol address from the network (4:51-5:5);

determining (32) if the Internet Protocol address assigned by the network is a private  
Internet Protocol address (4:51-5:5); and

upon (34) determining that the assigned Internet Protocol address is a private Internet  
Protocol address, self-configuring the network device to use a local area network port to access  
the Internet and the network (4:51-5:5).

As per claims 5 and 6:

Nurmann further discloses a method comprising:

Art Unit: 2132

Acquiring (31) an Internet Protocol address from the network (4:51-5:5);  
determining (32) if the Internet Protocol address assigned by the network is a private Internet Protocol address (4:51-5:5); and  
upon (34) determining that the assigned Internet Protocol address is a private Internet Protocol address, self-configuring the network device to use a local area network port to access the Internet and the network (4:51-5:5).

As per claims 15, 16, 18 and 19:

Nurmann further discloses a method (30) for automatically self-configuring a network device being added to a network comprising:

acquiring (31) an Internet Protocol address from the network; and  
self-configuring (33) the network device to act as a gateway to the Internet for the network based on a format of the Internet Protocol address wherein the format includes an address type and wherein the address type includes a private Internet Protocol address and the address type includes a format that matches 10.x.x.x (4:51-5:5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7, 9, 17, 20 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Nurmann in view of Kim, U.S. PG-PUB 2003/0214955.

Art Unit: 2132

As per claims 7, 9 and 17:

Nurmann fails to teach determining a public Internet Protocol address assigned to the network device and then self-configuring the network device to use a wide area network port to access the Internet and a local area network port to access the network. However, Kim discloses assigning a public Internet Protocol address to a network device and configuring the device to access the Internet through a wan port and the network through a lan port (paragraph 0008).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the known technique of assigning public IP addresses as disclosed in Kim, with the invention of Nurmann in order to yield the predictable result of determining whether the network device is needed to function as a gateway.

As per claims 20 and 21:

Nurmann substantially teaches a method (20) for automatically self-configuring a network device being added to a network comprising:

attempting (21) to access a NAT, DHCP or DNS service from the network, which NAT, DHCP or DNS service is also capable of being performed by the network device (4:36-50, claim 2);

upon (24) successfully accessing the DHCP service by the network device, disabling the NAT, DHCP or DNS service within the network device (2:43-67, claim 2); and

upon (23) unsuccessfully accessing the DHCP service by the network device, activating the NAT, DHCP or DNS service within the network device (2:43-67, claim 2);

acquiring (31) an Internet Protocol address from the network (4:51-5:5);

Art Unit: 2132

determining (32) if the Internet Protocol address assigned by the network is a private Internet Protocol address (4:51-5:5); and

upon (34) determining that the assigned Internet Protocol address is a private Internet Protocol address, self-configuring the network device to use a local area network port to access the Internet and the network (4:51-5:5).

Nurmann fails to teach determining a public Internet Protocol address assigned to the network device and then self-configuring the network device to use a wide area network port to access the Internet and a local area network port to access the network. However, Kim discloses assigning a public Internet Protocol address to a network device and configuring the device to access the Internet through a wan port and the network through a lan port (paragraph 0008).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the known technique of assigning public IP addresses as disclosed in Kim, with the invention of Nurmann in order to yield the predictable result of determining whether the network device is needed to function as a gateway.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin D. Sandoval whose telephone number is 571-272-7958. The examiner can normally be reached on Monday - Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kristin D Sandoval  
Examiner  
Art Unit 2132

KPS

KDS

  
Benjamin E. Lanner  
Examiner AU 2132